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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,668	01/26/2004	Huitao Liu	1033-LB1007	8818
60533	7590	05/14/2007		
TOLER SCHAFFER, LLP 8500 BLUFFSTONE COVE SUITE A201 AUSTIN, TX 78759			EXAMINER REGO, DOMINIC E	
			ART UNIT 2618	PAPER NUMBER
			MAIL DATE 05/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/764,668	LIU, HUITAO	
	Examiner	Art Unit	
	Dominic E. Rego	2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Oshima (US Patent #6,463,300).

Regarding claim 1, Oshima teaches a terminal having private content stored in a memory (Col 6, lines 19-55; Col 7, lines 9-30), the terminal comprising:

at least one smart card having first IMSI information or a first MSISDN/IMSI combination, that identifies the at least one smart card as an authorized smart card (Col 7, lines 24-30); and

a security function that associates the private content stored in the terminal memory with the first IMSI or first MSISDN/IMSI combination of the at least one authorized smart card to grant access to the private content only to the at least one authorized smart card (Col 6, lines 19-55; Col 7, lines 9-30).

Regarding claims 2 and 12, Oshima teaches the terminal, wherein the terminal comprises a mobile telephone (*Figures 1A-1C*).

Regarding claims 3 and 13, Oshima teaches the terminal, wherein the terminal comprises a communicator (*Col 7, lines 6-8*).

Regarding claims 4 and 14, Oshima teaches the terminal, wherein the at least one smart card comprises a SIM (*Col 7, lines 24-30*).

Regarding claim 5, Oshima teaches the terminal, wherein the terminal further comprises a private content IMSI/MSISDN associated with the private content, wherein the security function denies access to the private content to a smart card that is not an authorized smart card and grants access to the private content to an authorized smart card (*Col 6, lines 19-55; Col 7, lines 9-30*).

Regarding claims 6,7,10, and 11, Oshima teaches the terminal, wherein the private content comprises discreet items, and the private content IMSI/MSISDN is associated with each discreet item (*Col 6, lines 28-34: Ross teaches the memory section 25 has an SIM data storing section 252 storing a part of various data storing in the SIM card 26 inserted into the mobile station 10 when the mobile station 10 can previously access a mobile communication service network. The memory section 25 has a secret number storing section 251 for storing a secret number registered in the mobile station 10 itself*).

Regarding claim 8, Oshima teaches the terminal, wherein the terminal comprises a GSM terminal (*Col 1, lines 45-52*).

Regarding claim 9, Oshima teaches a method of controlling access to private content stored in a GSM/SIM mobile terminal (*Col 6, lines 19-55; Col 7, lines 9-30*), the method comprising the steps of:

providing the private content with private content IMSI/MSISDN information (*Col 7, lines 24-30*);

associating the private content IMSI/MSISDN information with at least one SIM from a plurality of SIMs, each SIM of the plurality of SIMs including respective IMSI/MSISDN information (Col 7, lines 35-Col 8, lines 60);

comparing the private content IMSI/MSISDN information with the IMSI/MSISDN information of a SIM from the plurality of SIMs to produce a comparison result (Col 6, lines 19-55; Col 7, lines 9-30);

denying access to the private content when the comparison result is negative (Col 6, lines 19-55; Col 7, lines 9-30); and

granting access to the private content when the comparison result is positive (Col 6, lines 19-55; Col 7, lines 9-30).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Ross et al. (US Patent #6,970,817).

Regarding claim 1, Ross teaches a terminal having private content stored in a memory (Col 2, lines 24-34; Col 2, line 54-Col 3, lines 31), the terminal comprising:

at least one smart card having first IMSI information or a first MSISDN/IMSI combination, that identifies the at least one smart card as an authorized smart card (*Col 3, lines 4-31: Ross teaches when the key is first generated, a copy is stored in the device, and associated with a VR tag. The key may also be stored in the removable media if the application permits (IMSI included in order to grant access to the stored key). If the key is not stored in the media, then the key must be based on record so that it can be generated later, and matched to the key stored in the device*); and

a security function that associates the private content stored in the terminal memory with the first IMSI or first MSISDN/IMSI combination of the at least one authorized smart card to grant access to the private content only to the at least one authorized smart card (*Col 2, lines 24-34; Col 2, line 54-Col 3, lines 31*).

Regarding claims 2 and 12, Ross teaches the terminal, wherein the terminal comprises a mobile telephone (*Col 1, lines 53-67*).

Regarding claims 3 and 13, Ross teaches the terminal, wherein the terminal comprises a communicator (*Col 1, lines 53-67*).

Regarding claims 4 and 14, Ross teaches the terminal, wherein the at least one smart card comprises a SIM (*Col 1, lines 53-67*).

Regarding claim 5, Ross teaches the terminal, wherein the terminal further comprises a private content IMSI/MSISDN associated with the private content, wherein the security function denies access to the private content to a smart card that is not an authorized smart card and grants access to the private content to an authorized smart card (*Col 2, lines 24-34; Col 2, line 54-Col 3, lines 31*).

Regarding claims 6,7,10, and 11, Ross teaches the terminal, wherein the private content comprises discreet items, and the private content IMSI/MSISDN is associated with each discreet item (*Col 2, line 54-Col 3, line 31*).

Regarding claim 8, Ross teaches the terminal, wherein the terminal comprises a GSM terminal (*Col 1, lines 53-67*).

Regarding claim 9, Ross teaches a method of controlling access to private content stored in a GSM/SIM mobile terminal (*Col 2, lines 24-34; Col 2, line 54-Col 3, lines 31*), the method comprising the steps of:

providing the private content with private content IMSI/MSISDN information (*Col 2, lines 24-34; Col 2, line 54-Col 3, lines 31*);

associating the private content IMSI/MSISDN information with at least one SIM from a plurality of SIMs (*Col 1, lines 53-67; Col 2, lines 24-34; Col 2, line 54-Col 3, lines 31*: *Ross teaches* a cellular radiotelephone having a subscriber identity module (SIM) for storing calling numbers and names or aliases associated with the calling numbers), each SIM of the plurality of SIMs including respective IMSI/MSISDN information (*Col 3, lines 4-16*);

comparing the private content IMSI/MSISDN information with the IMSI/MSISDN information of a SIM from the plurality of SIMs to produce a comparison result (*Col 2, lines 24-34; Col 2, line 54-Col 3, lines 31*);

denying access to the private content when the comparison result is negative (*Col 2, lines 24-34; Col 2, line 54-Col 3, lines 31*); and

granting access to the private content when the comparison result is positive (Col 2, lines 24-34; Col 2, line 54-Col 3, lines 31).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshima (US Patent #6,463,300) and in view of Carpenter (US Patent Application Publication #2005/0176409).

Regarding claim 15, Oshima teaches, a system for preventing unauthorized access to private content stored in the internal memory of a mobile terminal, the system comprising:

mobile equipment that accesses a wireless network by radio transmission and reception, wherein the mobile equipment comprises private content stored on the internal memory of the mobile equipment, and further wherein the private content, or a pre-determined portion thereof, is associated with IMSI information unique to an owner of the private content or the pre-defined portion of the private content (Col 6, lines 19-55; Col 7, lines 9-30); and

at least one SIM containing subscriber information and service or application profiles, wherein the SIM identifies the subscriber by IMSI information stored on the SIM (Col 6, lines 19-55; Col 7, lines 9-30);

wherein access to all or to the pre-defined portion of the private content occurs only when the IMSI/MSISDN information of the SIM correlates to the IMSI/MSISDN information of the private content, or of the pre-defined portion of the private content, stored in the memory of the mobile equipment (Col 6, lines 19-55; Col 7, lines 9-30), except mobile equipment that accesses a wireless network by radio transmission and reception using 3GPP protocols and at least one SIM containing subscriber information and service or application profiles, wherein the SIM identifies the subscriber by MSISDN information stored on the SIM.

However, in related art, Carpenter teaches mobile equipment that accesses a wireless network by radio transmission and reception using 3GPP protocols (Paragraphs 0032,0052,0069) and at least one SIM containing subscriber information and service or application profiles, wherein the SIM identifies the subscriber by MSISDN information stored on the SIM (Paragraph 0024).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Carpenter to Oshima in order to secure the private information that stores in the memory of mobile device.

Regarding claims 16 and 18, the combination of Ross and Oshima teach all the claimed elements in claim 15. In addition, Ross teaches the terminal, wherein the

private content comprises discreet items, and the private content IMSI/MSISDN is associated with each discreet item (*Col 6, lines 28-34: Ross teaches the memory section 25 has an SIM data storing section 252 storing a part of various data storing in the SIM card 26 inserted into the mobile station 10 when the mobile station 10 can previously access a mobile communication service network. The memory section 25 has a secret number storing section 251 for storing a secret number registered in the mobile station 10 itself*).

Regarding claims 17, the combination of Oshima and Carpenter teach all the claimed elements in claim 15. In addition, Oshima teaches the system, wherein the private content comprises one or more of the following items: (a) one or more ring tones, (b) one or more games, (c) one ore more images, (d) one or more video files, or (d) one or more audio files (*Col 6, lines 28-34: Ross teaches the memory section 25 has an SIM data storing section 252 storing a part of various data which can be ring tone or game or image storing in the SIM card 26 inserted into the mobile station 10 when the mobile station 10 can previously access a mobile communication service network. The memory section 25 has a secret number storing section 251 for storing a secret number registered in the mobile station 10 itself*).

Regarding claim 20, the combination of Oshima and Carpenter teach all the claimed elements in claim 15. In addition, Oshima teaches the terminal, wherein the terminal comprises a mobile telephone (*See Figures 1A-1C*).

Response to Arguments

7. Applicant's arguments, see pages 1-5, filed 07/14/2006, with respect to the

Art Unit: 2618

rejection(s) of claim(s) 1-20 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Ross et al. (US Patent #6,970,817), Oshima (US Patent #6,463,300) and Carpenter (US Patent Application Publication #2005/0176409).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gehrmann et al. (US Patent Application Publication #2004/0176071) teaches secure remote subscription module access.

Jiang (US Patent Application Publication #2006/0276226) teaches signaling gateway with multiple IMSI with multiple MSISDN service in a single SIM for multiple roaming parters.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic E. Rego whose telephone number is 571-272-8132. The examiner can normally be reached on Monday-Friday, 8:30 am-5 pm.

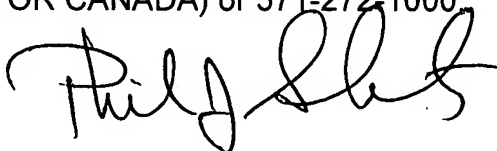
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 571-272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2618

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dominic E. Rego



PHILIP J. SOBUTKA
PATENT EXAMINER

5/9/7